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REMARKS

Claims 1, 4-11, and 13-25 are currently pending in the subject application and are presently under consideration. Claims 1, 11, 20 and 21 have been amended herein. Claim 25 has been added. A listing of all claims can be found at pages 2-6. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 4-11, 13-20 and 22-24 Under 35 U.S.C. §103(a)

Claims 1, 4-11, 13-20 and 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Electro-tech systems, Inc. (ETS) "Ground strap testers" (09/1997) in view of Schechtel *et al.* (U.S. 6,416,090). This rejection should be withdrawn for at least the following reasons. Neither ETS nor Schechtel *et al.* teach or suggest all limitations recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed invention relates to a system and apparatus having one or more indicators that are viewable from multiple directions. (See *e.g.*, pg. 2, lns. 8-10). Independent claim 1 (and its corresponding dependent claims) recites *an indicator apparatus, comprising ... a housing having a first side extending generally between second and third sides, the housing containing circuitry for performing a proximity sensing function ... and part of a strip is visible at a first side and at least one of a second and third sides*. Independent claim 11 recites *an indicator*

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system, comprising ... **a housing containing an object detection circuit, and a translucent material visible at a first side and at least one of a second and third side (of a housing).**

Similarly independent claim 20 recites **an indicator apparatus, comprising housing means having an outer sidewall portion and a network means that detects an object and translucent means affixed to the housing ... for transmitting emitted light from an illumination means so as to be visible from a plurality of sides of an outer sidewall portion of the housing means.** The indicator arrangement provides improved visibility from multiple angles. (See e.g., pg. 2, lns. 4-5). Sensing probes are located remote from the housing and/or electronics are contained within the housing to determine the proximity (e.g. presence or absence) of a target. (See e.g., pg. 8, lns. 5-13; pg. 9, lns. 1-6). Neither ETS nor Schechtel *et al.* teach or suggest such features.

ETS relates to a utility wiring verifier that provides verification of AC outlet ground and point-to-ground connections to determine if an outlet has been correctly wired. (See e.g. pg. 2, col. 2, lns. 20-22 and 26-27). ETS does not teach or even suggest circuitry for performing a proximity sensing function as in the claimed invention. Schechtel *et al.* relates to a locking mechanism for a modem enclosure to minimize latch mechanism failure during impact testing. (See e.g., col. 1, lns. 5-7 and lns. 38-40). Both ETS and Schechtel *et al.* are silent regarding an indicator apparatus, comprising a housing containing circuitry for performing a proximity sensing function.

Based on at least the foregoing, and the arguments presented *infra* in Section II, it is submitted that this rejection be withdrawn and the subject claims allowed.

II. Rejection of Claim 21 Under 35 U.S.C. §103(a)

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Schneider *et al.* (U.S. D391,182) in view of ETS and further in view of Schechtel *et al.* This rejection should be withdrawn for at least the following reasons. The cited references do not teach or suggest all limitations recited in the subject claim and the proposed combination would render the cited references inoperable for their intended purpose.

If a reference is cited that requires some modification in order to meet the claimed invention or requires some modification in order to be properly combined with another reference and such a modification destroys the purpose or function of the invention

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disclosed in the reference, one of ordinary skill in the art would not have found a reason to make the claimed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Claim 21 (and its dependent claims) recites *a proximity sensor system, comprising ... a proximity sensor for sensing the proximity of an object ... and ... at least one elongated strip of substantially translucent material ... part of the strip is visible at least one side and another side of a sidewall portion*. Independent claims 1, 11, and 20 recite similar limitations as discussed *supra* in section I, and the arguments presented herein apply equally to these claims.

ETS relates to an apparatus that provides verification of correct wiring of an AC outlet. (See *e.g.* pg. 2, col. 2, lns. 20-22 and 26-27). ETS does not teach or even suggest circuitry for performing a proximity sensing function as in the claimed invention. Schneider *et al.* relates to an ornamental design for a proximity sensor. The Office Action incorrectly asserts it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the indicator of Schneider *et al.* with the teaching of ETS to render the claimed invention.

A purpose of the claimed invention is to provide indicators that are viewable from multiple directions. (See *e.g.*, pg. 1, lns. 5-6). As depicted in figures 1 and 2 of the subject application, the apparatus has an elongated strip of substantially translucent material that is viewable from at least one side and another side of a housing sidewall portion. The apparatus has probes 90 and 92 that extend from the side and underneath the apparatus to allow the proper viewing of the indicators when the apparatus is mounted.

On the other hand, the apparatus of Schneider *et al.* has cables that project straight out of the apparatus, rendering the apparatus unable to be mounted along the wall of the apparatus from which the cables project. (See *e.g.*, figures 1 and 2). Thus, if the Schneider *et al.* design is modified to include the indicator lights of ETS as suggested in the office action, the modified indicator of Schneider *et al.* would allow viewing of the modified indicators from only two directions. Viewing from a third direction (or sidewall) would not be possible because the apparatus can not be mounted on the side from which the cables extend and must be mounted on one of the other sides. This mounting would completely obstruct the viewing of the indicators from at least one angle. The Examiner is reminded that design applications are limited to the embodiments illustrated in the figures. Modification of the Schneider *et al.* indicator as suggested would require a modification that destroys the purpose of the Schneider *et al.* patent,

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which is the particular ornamental design for an indicator as illustrated. Moreover, the suggested modification would not render the subject application obvious because the cited references, even if combined, do not teach or suggest at least one elongated strip of substantially translucent material ... part of the strip is visible at least one side and another side of a sidewall portion, because of the mounting limitations of the Schneider *et al.* apparatus.

Additionally, Schechtel *et al.* relates to a locking mechanism for a *modem enclosure* to minimize latch mechanism failure during impact testing. (See *e.g.*, col. 1, lns. 5-7 and lns. 38-40). Absent some teaching or suggestion in the prior art to combine elements, it is insufficient to establish obviousness by claiming that the separate elements of the invention existed in the prior art. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). Applicants' representative submits that one skilled in the art of indicator apparatuses would not have looked to the non-analogous art of Schechtel *et al.*, related to modem enclosure locking mechanisms, to make up for the aforementioned deficiencies of ETS and/or Schneider *et al.*

Based on at least the foregoing, the rejection of independent claim 21 (and independent claims 1, 11 and 20) and corresponding dependent claims should be withdrawn and the subject claims allowed.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [ALBRP183US]

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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